

## **REMARKS/ARGUMENTS**

### **INTRODUCTORY COMMENTS**

Initially, Applicant thanks the Examiner for the detailed Official Action that has been provided. Upon entry of the above amendment, claims 17-19 and 22-31 will have been amended, and claims 1-16, 20-21 and 32 will have been canceled. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

### **SUMMARY OF THE OFFICIAL ACTION**

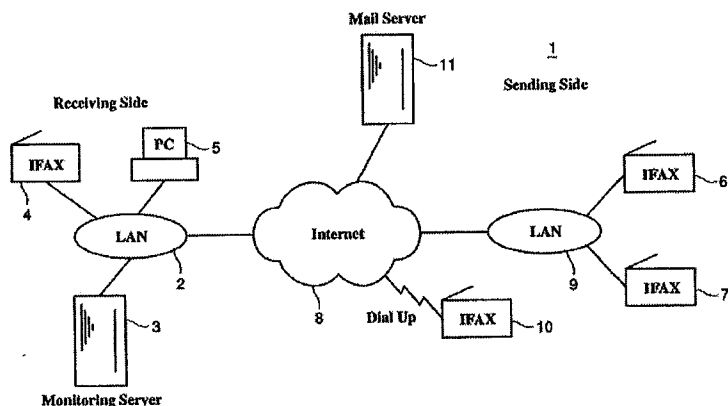
Turning to the merits of the action, claims 17-20, 23, 26, 29, 30 and 31 stand rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 5,960,442 to PICKERING. Claims 22, 25, 27, and 28 stand rejected under 35 U.S.C §103(a) as being unpatentable over PICKERING in view of U.S. Patent Publication No. 2002/0051168 to YASHIKI. Claims 24 and 27 stand rejected under 35 U.S.C §103(a) as being unpatentable over PICKERING in view of YASHIKI and U.S. Patent No. 6,853,714 to LILJESTRAND et al. Applicant respectfully traverses the grounds of rejection for the reasons to be discussed below.

### **APPLICANT'S CLAIMED INVENTION**

Applicant's invention, as defined by the claims, generally relates to a transmitting apparatus for sending an Internet facsimile ("IFAX") 6 or 7 to a receiving apparatus for receiving

the Internet facsimile, such as a computer 5 or IFAX 4. For convenience, FIG. 1 of the present application is reproduced below:

Fig. 1

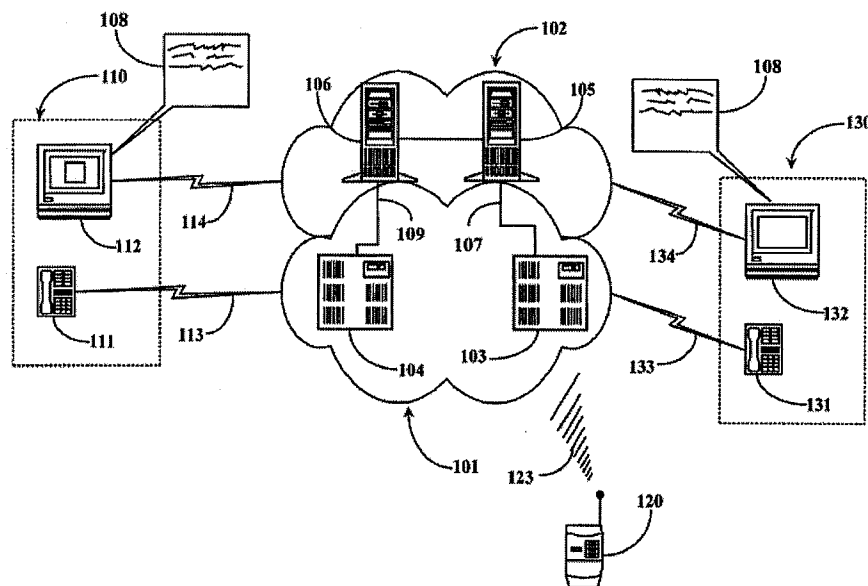


According to a disclosed embodiment of the presently claimed invention, the receiving apparatus for receiving the Internet facsimile 4 exchanges data with a monitoring apparatus 3 that monitors a status of the receiving apparatus 4. The monitoring apparatus 3 is distinct from the receiving apparatus for receiving the Internet facsimile 4. The transmitting apparatus or IFAX 6 or 7 includes a receiver that receives, from the monitoring apparatus 3, status information of the receiving apparatus 4 or 5, and a memory that stores the status information of the receiving apparatus 4 or 5. The transmitting apparatus or IFAX 6 or 7 further includes a controller that checks the status information of the receiving apparatus 4 stored in the memory of the transmitting apparatus without accessing the monitoring apparatus 3 when destination information of the receiving apparatus 4 is input for a transmission of transmitting data to the receiving apparatus 4. The controller notifies a user of the transmitting apparatus or IFAX 6 or 7 of the status information of the receiving apparatus prior to the transmission of the transmitting data to the receiving apparatus. The controller additionally transmits the data to the receiving

apparatus when the receiving apparatus is available, based on the status information of the receiving apparatus stored in the memory of the transmitting apparatus.

### **PICKERING DOES NOT ANTICIPATE CLAIMS 17-19, 23, 26, 29, 30 and 31**

With respect to the rejection of claims 17-19, 23, 26, 29, 30 and 31 under 35 U.S.C. §102(e), Applicant submits that PICKERING relates to an interactive directory that is provided for a workstation connected to a video monitor, and an interactive display that displays the status for individual entities. The interactive display interface of PICKERING is adapted for use in a computer-telephony environment of the type illustrated in FIG. 1 of PICKERING. For convenience, FIG. 1 of PICKERING is reproduced below:



*Fig. 1*

Workstations 110, 130 access status information from network sources associated with individual directory listings of FIG. 2. For example, real time interactive display ("RTID") application 108 executes on PC 112. A user at workstation 110 selects a name among the list

displayed at PC 112, such as, for example, John Doe. The RTID application 108 provides the remote source for real-time information for John Doe. In this case, the remote source is a computer telephony integration (“CTI”) application running on server 105. The RTID application 108 accesses the CTI server 105 over the Internet and negotiates for access to information on John Doe’s status. When access is granted, status information on John Doe is passed over the Internet to PC 112 at station 110 (see, for example, col. 5, lines 12-24 of PICKERING).

Applicant respectfully submits that the interactive directory and display for use in a computer-telephony environment of PICKERING does not anticipate the claimed receiving apparatus for receiving an Internet facsimile, the transmitting apparatus for transmitting the Internet facsimile, or the status information of the receiving apparatus. Since none of these claim recitations are present in PICKERING, there is no disclosure or need for sending, to the transmitting apparatus, the status information, which includes an indication that the receiving apparatus is unable to print the transmitting data, as now recited in each of the independent claims 17, 23, 26, 29, 30 and 31. Accordingly for all of these reasons, Applicant respectfully submit that claims 17-19, 23, 26, 29, 30 and 31 are not anticipated by PICKERING, and the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. §102(e).

#### **YASHIKI FAILS TO CURE THE DEFICIENCIES OF PICKERING**

With respect to the rejection of claims 22, 25, 27, and 28 under 35 U.S.C. §103(a), Applicant submits that YASHIKI fails to disclose that which is lacking in PICKERING. YASHIKI. is directed to an Internet facsimile apparatus that transmits a facsimile to a server via

the Internet, and YASHIKI recognizes a significant shortcoming in such devices. More specifically, in paragraph [0027], YASHIKI acknowledges:

Typically, IFAX 1 is not provided with any mass storage system. Therefore, it [sic] IFAX 1 is unable to print the data or file which is forwarded thereto for any one of a number of possible reasons, either the sender experiences a transmission failure or the transmitted data is left in a mail server that may not be readily accessible for the recipient. This can occur when the printer of IFAX 1 has failed, when the memory of IFAX 1 has become full, and when the received file is not a TIFF file.

Contrary to the solution disclosed and claimed by Applicant, YASHIKI provides an entirely different solution to the printing problem that actually teaches away from Applicant's claimed invention. YASHIKI teaches in paragraph [0028]:

To avoid this problem, IFAX 1 according to the present invention is adapted to transfer the received file to POP server 8. If desired, the received file may be transferred to administrator PC 7, or other IFAX 10. Once the problem with IFAX 1 has been corrected, and IFAX 1 has become capable of printing or otherwise processing the received file, the received file is retrieved from POP server 6 and printed at IFAX 1. If the received file is not a TIFF file, it is rerouted to administrator PC 7 to be printed, displayed or otherwise processed at administrator PC 7.

In other words, YASHIKI teaches one skilled in the art that if the receiving IFAX has a problem printing the facsimile, the received file is transferred to and retrieved from a POP server, or transferred to another POP server or PC and printed.

#### **THE ASSERTED COMBINATION OF PICKERING AND YASHIKI IS NOT APPLICANT'S CLAIMED INVENTION**

Applicant respectfully submits that even if PICKERING and YASHIKI are combined as asserted in the Official Action, the resulting combination would not be Applicant's claimed invention. Applicant asserts that if one skilled in the art combined PICKERING and YASHIKI, the skilled artisan would merely use the status information provided in PICKERING's real-time

interactive directory to determine if there is a problem printing a facsimile with the IFAX 1 of YASHIKI. If a problem exists with the printing of facsimile with the IFAX 1 of YASHIKI, the hypothetical system asserted in the Official Action would then transfer the file to a POP server for later retrieval, or transfer the file to a different POP server or PC for printing in accordance with YASHIKI. (See, paragraph [0028] reproduced above.) Accordingly, the hypothetical combination of PICKERING and YASHIKI is not Applicant's claimed invention which includes status information having an indication that the receiving apparatus for receiving the Internet facsimile is unable to print the transmitting data, and the Examiner is respectfully requested to withdraw the rejection of claims 22, 25, 27, and 28 under 35 U.S.C. §103(a).

**LILJESTRAND ET AL. FAILS TO CURE THE DEFICIENCIES OF PICKERING AND YASHIKI**

With respect to the rejection of claims 24 and 27 under 35 U.S.C. §103(a), Applicant submits that LILJESTRAND et al. fail to disclose that which is lacking in PICKERING and YASHIKI. LILJESTRAND et al. is directed to an apparatus and method for providing transparent enhanced telecommunications services to subscribers by implementing an enhanced services platform on a local network exchange within the public telephone network.

Applicant submits that LILJESTRAND et al. fail to disclose (or even suggest) the printing of a facsimile by an IFAX based upon status information of a receiving apparatus for receiving the Internet facsimile stored in a memory of a transmitting apparatus for transmitting the Internet facsimile without accessing a monitoring apparatus when destination information of the receiving apparatus for receiving the Internet facsimile is input for a transmission of transmitting data to the receiving apparatus for receiving the Internet facsimile. Applicant

submits that LILJESTRAND et al. also does not contain disclosures regarding a monitoring apparatus that monitors a status of the receiving apparatus for an receiving Internet facsimile. Thus, Applicant submits that LILJESTRAND et al. fails to disclose a receiver that receives, from the monitoring apparatus, status information of the receiving apparatus, as well as a memory that stores the status information of the receiving apparatus. For this reason, Applicant submits that LILJESTRAND et al. fails to disclose a controller that checks status information of a receiving apparatus stored in a memory of a transmitting apparatus without accessing a monitoring apparatus, when destination information of the receiving apparatus is input for a transmission of transmitting data to the receiving apparatus, as well as a controller that notifies a user of the transmitting apparatus, the status information of the receiving apparatus prior to the transmission of the transmitting data to the receiving apparatus.

Accordingly, Applicant submits that even if one attempted to combine the teaching of PICKERING with the teaching with YASHIKI et al. and LILJESTRAND et al., in the manner suggested by the Examiner, one would fail to arrive at the presently claimed invention, as such a combination would lack, at least, a transmitting apparatus for sending the Internet facsimile that checks status information of a receiving apparatus for receiving the Internet facsimile stored in a memory without accessing a monitoring apparatus (the monitoring apparatus being distinct from the receiving apparatus), when destination information of a receiving apparatus is input for a transmission of transmitting data to the receiving apparatus, and further, notifies the user of the transmitting apparatus of the status information of the receiving apparatus prior to (before) a transmission of the transmitting data to the receiving apparatus. Therefore, Applicant submits that the suggested combination of PICKERING, YASHIKI and LILJESTRAND et al. fails to

render the presently claimed invention, as defined by claims 24 and 27 obvious, and thus, respectfully requests that the 35 U.S.C. §103(a) rejection of claims 24 and 27 be withdrawn.

### **SUMMARY AND CONCLUSION**

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.

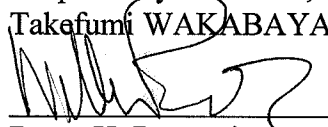
Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has done so. Applicant has amended the rejected claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out features thereof noted taught by the cited references and has contrasted features of the pending claims with the disclosures of the references. Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application, and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time fee under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.



Should the Examiner have any questions or comments regarding this response, or the present application, the Examiner is requested to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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